

REMARKS

The preceding amendments and following remarks form a full and complete response to the Office Action dated May 19, 2009. The Specification has been amended to correct an error in the translation from the original German to English. Specifically, the German term “Folie” is more appropriately translated as “foil” instead of “film.” Accordingly, the Specification has been amended to change the term “film” to “foil” throughout. Support for the amendment to the Specification can be found, *inter alia*, in the original German-language specification as filed. No new matter is added. Applicants have amended claims 1, 4, 5, 7, 8, 10 and 11 without adding any new matter. Support for the claim amendments can be found, *inter alia*, in ¶ 24 of the Specification¹. Applicants have also added new claims 13 -15, which find support, *inter alia*, in ¶¶ 24, 30, and 41-45 of the Specification. Claim 11, which was previously withdrawn from consideration, has also been amended only to correct the translation error. Accordingly, claims 1-15 are pending and submitted for consideration.

Claim 5 was rejected under 35 U.S.C. § 112, second paragraph, for its alleged indefiniteness in light of the fact that it contains the language “not very pronounced surface relief.” While Applicants disagree that this language lacks definiteness, in the interest of advancing prosecution, Applicants have deleted “not very pronounced” from claim 5. Applicants submit, therefore, that claim 5, as amended, meets all the requirements of 35 U.S.C. § 112, second paragraph. Accordingly, Applicants respectfully request the withdrawal of the rejection of claim 5.

¹ Unless otherwise noted, citations to the Specification refer to U.S. Patent Application Publication No. 2006/0107854

Claims 1-7, 9-10, and 12 were rejected under 35 U.S.C. § 102(b) as anticipated or under 35 U.S.C. § 103(a) as rendered obvious by U.S. Patent No. 6,471,248 to Hardwick et al. (“Hardwick”). Applicants traverse the rejection on the basis that claims 1-7, 9-10, and 12 recite subject matter neither disclosed nor suggested by Hardwick.

Claim 1 recites a data carrier having a first side and a second side. The data carrier includes at least one printed area produced by intaglio printing on the first side. The intaglio printing has a tactile perceptibility and a printing relief of approximately 5 to 100 microns. The data carrier also includes a foil applied to the first side that partly covers the printed area. The foil is applied such that the tactile perceptibility of the intaglio printing is maintained. The Examiner contends that all of these features of claim 1 are disclosed by Hardwick. See Office Action at 3-4. They are not.

For instance, as stated previously, Hardwick fails to disclose or suggest a data carrier having a printed area with tactile perceptibility, as defined by claim 1. Instead, Hardwick discloses a security document comprising a sheet-like substrate of clear plastic material having a lower surface 11 and a second upper surface 12. See Hardwick at col. 3, lines 55-64; FIG 1. The security document also includes a security device 20 on the lower surface 11 of the clear plastic substrate 10. The security device 20 is embedded in the security document between the substrate 10 and layers of opacifying ink 13 and 14 which completely cover both sides of the device 20. The opacifying layers of ink 15 and 16 are not applied over the entire surface 12 of the substrate 10 and thus leave an area of the second surface 12 that is not covered by the ink, which forms a “half-window” 18 on one side of the substrate. *Id.* None of this is

tactilely perceptible as required by claim 1. This is not surprising given that Hardwick is more concerned with maintaining visibility than tactile perceptibility.

The Examiner suggests that “the areas where and where not are [sic] printed and embossed are inherently tactilely perceptible.” See Office Action at 3. Applicants submit, however, that there is nothing inherently tactilely perceptible about the printed and embossed areas described by Hardwick. To establish inherency, the Examiner “must make clear that the missing descriptive matter is necessarily present in the thing described in the references and that it would be so recognized by persons of ordinary skill in the art.” See MPEP § 2112, subparagraph IV. “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” *Id.* (emphasis in original). When an examiner relies on inherency to show the existence of something in the prior art, the examiner “must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art.” *Id.* (emphasis in original).

In the present case, the intaglio printing allows even a layman to determine the authenticity of a data carrier because the printing has the characteristic that it is easily palpable and readily recognizable by the tactility, which is not reproducible by a copy machine. See Specification at ¶ 9. By contrast, Hardwick fails to disclose the tactility of the printed and embossed areas that the Examiner alleges are inherently tactilely perceptible. Indeed, Applicants submit that there are many prints and embossings that lack the tactile perceptibility required by claim 1. For instance, the print on a page printed by a laser printer lacks tactile perceptibility within the meaning of claim 1. One

of ordinary skill in the art, therefore, would not understand Hardwick to inherently disclose a printed area having tactile perceptibility, as required by claim 1. For this reason alone, the rejection of claim 1 is improper and should be withdrawn.

Claim 1 is also patentable over Hardwick because Hardwick (as the Examiner seems to acknowledge) fails to disclose or suggest a printed area produced by intaglio printing, as required by claim 1. The Examiner alleges that intaglio printing need not be shown in Hardwick because “product-by-process claims are not limited to the manipulations of the recited stapes, only the structure implied by the steps.” However, Applicants submit that the term “intaglio printing” does not make claim 1 a product-by-process claim, but imposes a structural limitation on the claim. Such an interpretation of the claim term is in accordance with the applicable Federal Circuit precedent. For instance, in *3M Innovative Props. Co. v. Avery Dennison Corp.*, the Federal Circuit found that the District Court had improperly construed the claim term “embossed” to impose a process limitation despite the fact that the patentee had described the term in such a way as to make it structural. 350 F.3d 1365, 1374 (Fed. Cir. 2003) (finding the term “embossed” to be “entirely structural”). Instead, the Federal Circuit found that, because the patentee had described “embossed” as having certain characteristics, the patent was not limited to how the embossed portion was created, but to the characteristics of an embossed pattern. *Id.*

The present case is analogous to *3M*. The term “intaglio printing,” as used in the present application, clearly describes a characteristic of a certain kind of print and not necessarily the process by which the print is made. As explained in the Specification, an intaglio print has a comparatively thick ink layer and partial deformation of the paper

surface which is easily palpable manually even to the layman. See Specification at ¶ 9. Thus, the term “intaglio printing” imposes a structural limitation on claim 1 and must be shown in the prior art in order to render claim 1 either anticipated or obvious. Since Hardwick fails to disclose or suggest a printed area produced by intaglio printing and partly covered by a foil, the rejection of claim 1 is improper for this separate and independent reason.

The rejection of claim 1 is also improper for the separate and independent reason that the Examiner has failed to establish that Hardwick discloses or suggests a printed area that is the structural equivalent of a printed area produced by intaglio printing. Even if the Examiner were correct that claim 1 is a product-by-process claim, the Examiner must still consider the structure that results from the process steps when assessing the patentability of claim 1. See MPEP § 2113. As stated earlier, intaglio printing produces a very unique kind of print: it has a tactility that is perceptible to a layman and cannot be copied by a copy machine. See Specification at ¶ 9. The Examiner has not even alleged that an equivalent structure is present in Hardwick. Accordingly, for this separate and independent reason, the rejection of claim 1 is improper and should be withdrawn.

Additionally, Applicants have amended claim 1 in the interest of furthering prosecution to define the printed area as “having a printing relief of approximately 5-100 microns.” Applicants submit that Hardwick fails to disclose or suggest this feature of claim 1. For this separate and independent reason, the rejection of claim 1 is improper and should be withdrawn.

Additionally, claim 1 request that the data carrier also includes a foil applied to the first side that partly covers the printed area. Applicants submit that Hardwick fails to disclose or suggest this feature of claim 1. For this separate and independent reason, the rejection of claim 1 is improper and should be withdrawn.

Thus, Hardwick fails to disclose or suggest each and every feature of claim 1. Applicants, therefore, respectfully request the withdrawal of the rejection of claim 1. Claims 2-6, 9-10, and 12 are patentable for at least the same reasons stated above with respect to claim 1, from which they depend either directly or indirectly, as well as for the additional features they recite. Applicants, therefore, respectfully request the withdrawal of the rejection of claims 2-6, 9-10, and 12 as well.

The Examiner rejected claims 1-10 and 12 under 35 U.S.C. § 103(a) as unpatentable over Hardwick in view of U.S. Patent No. 6,505,779 to Power et al. ("Power"). Applicants traverse the rejection on the basis that claims 1-10 and 12 recite subject matter neither disclosed nor suggested by the combination of Hardwick and Power.

Claim 1, as discussed above, is patentable over Hardwick. Power, which the Office cites for its general disclosure of the existence of intaglio printing, fails to remedy the deficiencies of Hardwick with respect to claim 1.

Power relates to a security document with a number of security indicia formed of at least partly transparent windows. See Power at col. 3, lines 27-32. Power discloses that it is possible to hide security indicia within "confusing information structures." *Id.* at col. 4, lines 1-9. To that end, Power discloses that the security indicial can be placed in

areas where there is intaglio printing. *Id.* at col. 5, lines 30-47. The height of the intaglio printing aids in concealing the security indicia. *Id.*

Power fails to remedy any of the deficiencies stated above with respect to Hardwick. For instance, while Power does disclose the existence of intaglio printing, it entirely fails to disclose a printed area produced by intaglio printing and having a printing relief of approximately 5 to 100 microns as claim 1 requires. It also fails to disclose or suggest a foil applied on a first side of a data carrier and partly covering the printed area such that the tactile perceptibility of the intaglio printing is maintained, as claim 1 also requires. Accordingly, the Power fails to remedy the deficiencies of Hardwick with respect to claim 1. Applicants, therefore, respectfully request the withdrawal of the rejection of claim 1. Claims 2-10 and 12 are patentable over the combination of Hardwick and Power for at least the same reasons stated above with respect to claim 1, from which they depend either directly or indirectly, as well as for the additional features they recite. Applicants, therefore, respectfully request the withdrawal of the rejection of claims 2-10 and 12.

The Examiner rejected claims 5 and 7 under 35 U.S.C. § 103(a) as unpatentable over the combination of Hardwick, Power, and U.S. Patent No. 6,474,695 to Schneider et al. ("Schneider"). Applicants traverse the rejection on the basis that claims 5 and 7 recite subject matter neither disclosed nor suggested by the combination of Hardwick, Power, and Schneider. For instance, claims 5 and 7 are patentable over the combination of Hardwick and Power for at least the same reasons stated above. Schneider, which the Examiner merely cites for its purported disclosure of holograms, fails to remedy the deficiencies of Hardwick and Power with respect to claims 5 and 7.

Applicants, therefore, respectfully request the withdrawal of the rejection of claims 5 and 7.

Applicants have added new claims 13 to 15. New claim 13 depends from claim 1 and is, therefore, patentable for at least the same reasons stated above with respect to claim 1. Independent new claim 14 recites a data carrier having a first side and a second side. The data carrier includes a substrate having an area containing print. The print is a raised relief that has a tactile perceptibility. A foil is applied to the first side of the data carrier such that a window area is maintained over at least a portion of the area containing said intaglio print so that the tactile perceptibility of the intaglio print is maintained. Dependent claim 15 recites the data carrier according to claim 14 wherein the relief of the intaglio print is approximately 5 to 100 microns. Claims 14 and 15 contain subject matter neither disclosed nor suggest by the cited prior art. For instance, claim 14 recites an area containing intaglio print with a raised relief having a tactile perceptibility and a foil with a window area that maintains the tactile perceptibility of the intaglio print. As discussed above, the prior art fails to disclose or suggest these features. Accordingly, the subject matter of claims 14 and 15 is allowable over the cited art. Applicants, therefore, respectfully request that the Office allow claims 14 and 15.

CONCLUSION

In view of the above, all rejections have been sufficiently addressed. Applicants submit that the application is now in condition for allowance and request that the Office allow claims 1-10 and 12-15 and pass this application to issue.

In the event that this paper is not timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account No. 02-2135.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

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